UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,812	03/30/2001	David W. Cannell	05725.0783-00	5365

22852 7590 02/09/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER	
WANG, SHENGJUN	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/820,812	CANNELL ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-100* is/are pending in the application.

4a) Of the above claim(s) *7-16,18,20,21,34-42,55-64,66-69 and 82-90* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,17,19,22-33,43-54,65,70-81,91-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 7, 2003 has been entered.

In the remarks submitted November 7, 2003, applicants elected to prosecute invention group I, claims 1-100, and canceled all the claims in group II. In a telephone conversation with Ms. Maria Bautista on January 30, 2004, Ms. Bautista indicates that applicant would maintain the species election made on paper submitted on March 13, 2002, i.e., elect with traverse, (a) XYLIANCE as at least one compound chosen from C3 to C5 monosaccharides substituted with at least one C1-C22 carbon chain, (b) xylose as at least additional sugar, and (C) Amphomer LV-71 as the at least one film forming agent.

2. Claims 7-16, 18,20-21, 34-42, 55-64, 66-69, 82-90 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

3. The claims have been examined insofar as they read on elected species.

Double Patenting Rejections

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 44-146 of U.S. Patent No. 6,486,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims herein are generic to the claims presented in '105.

Claims Rejections 35 U.S.C. 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-6, 17, 19, 22-33, 43-54, 65, 70-81, 91-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karlen et al (US Pat. 6,004,545) in view of Bertho et al (US Pat. 5,688,930) or Bertho et al (US Pat. 6,087,403).

Karlen teaches a hair cleansing composition with fixing properties. Karlen teaches the compositions can contain amphoteric film-forming polymers (see col. 7, lines 4-15), specifically teaching that suitable amphoteric polymers for use in the compositions include AMPHOMER LV-71 (see col. 8, lines 1-16). The composition necessarily include a surfactant chosen from a group that includes nonionic surfactants (see col. 2, lines 6-20). Karlen teaches that suitable

nonionic surfactants such as alkylpolyglucosides are particularly preferred (see col. 4, lines 23-39).

Karlen does not teach expressly the employment of a mixture of hexadecyl and octadecyl glycosides associated with a heating step.

However, Bertho (6930) teaches mixtures of alkyl glycosides from wheat by-products, such as wheat straw (see abstract). The mixtures are useful as surfactants, including hair care applications (see col. 6, lines 1 1-35, especially line 21). The mixture of glycosides includes glucose, xylose, and arabinose (see col. 2, Lines 35-45). Xylose is inherently present in the mixtures. The alkyl groups taught by Bertho range from 6-22 carbon atoms, particularly 14-20 carbon atoms (see col. 3, Lines 53-67*, and col. 7, Lines 6-9). The mixtures are included at 0.1-60% by weight in order to give surface-active properties to a composition (see col. 7, Lines 13-18). The surfactants taught by Bertho come from cheap raw material and have economic advantages over alkylpolyglucosides (see col. 1, Lines 35-53). Bertho (.403) teaches emulsifying compositions based on fatty alcohols and polyglycoside mixtures (see col. 2, lines 52-67, col. 3, lines 1-40, and col. 5, lines 16-25). The compositions are used as emulsifiers (see col. 6, Lines 31-43, and col. 7, lines 18-25). Bertho teaches that the compositions are advantageously cheaper than those based on purified glucose (see col. 5, lines 39-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hair compositions of Karlen by the use of alkylglycoside mixtures disclosed by Bertho instead of alkylpolyglucosides in order to benefit from the emulsifying properties of the polyglycosides or economic advantages as taught by Bertho ('930) or Bertho ('403). Further, drying hair by heating followed the employment of hair-

care composition is a common practice. As to the limitation "protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage," note when people use the hair care products as suggested by the prior art, the recited function would be inherently realized.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554 ((571)272-0632 after February 3, 2004). The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877 ((571)272-0629 after February 3, 2004). The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Primary Examiner

S. W

Shengjun Wang

January 31, 2004